

Customer No.: 31561
Application No.: 10,709,413
Docket No.: 12322-US-PA

REMARKS

Present Status of Application

The Office Action dated April 19, 2005, rejected claims 1-9 under 35 U.S.C. 112, 2nd paragraph as being indefinite. The Office Action further rejected claims 1, 2, 4-6 and 9 under 102(b) as being anticipated by Okamoto et. al. (US 2003/0059817) and claims 3 and 7-8 under 35 USC§103(a) as being unpatentable over Okamoto in view of Chen et al. (US 6,594,432) and Oprandy (US 5,200,312), respectively.

Claims 1-9 remain pending of which claims 1, 3-5 have been amended. It is believed that no new matter is added by way of these amendments made to the claims or otherwise to the application.

Applicant has most respectfully considered the remarks set forth in this Office Action. Regarding the obvious rejections, it is however strongly believed that the cited references are deficient to adequately teach the claimed features as recited in the presently pending claims. The reasons that motivate the above position of the Applicant are discussed in detail hereafter, upon which reconsideration of the claims is most earnestly solicited.

Discussions for 112 rejections

Claims 1-9 are rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, Claims 1, 3 and 4 are rejected for

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reciting a step of designing a plurality of probes, wherein the term designing is vague. Claim 1 is also rejected for reciting the phrase "spotting the probe molecules respectively" because it is unclear.

In response thereto, Applicants have amended claim 1 to recite "...selecting a plurality of probe molecules, wherein an affinity exists between each of the probe molecules and one of corresponding specific molecules on a cell membrane..". As taught in the embodiment of the invention, different types of diseases show different antigen reactions on the surface of the pathologically changed cells. In order to detect the type of diseases that a patient is suffering from, the antigens in which the antibody produced in response to the antigens are selected to form the probe molecules, for example.

Applicants have also amended claim 1 to recite "...spotting the probe molecules respectively onto respective positions of the matrix.." to more accurately describe the invention.

Discussions for 102 & 103 rejections

Claims 1, 2, 4-6 and 9 were rejected under 35 USC §102(b) as being anticipated by Okamoto et al. (US Patent Publication No. 2003/0059817).

In order to properly anticipate Applicant's claimed invention under 35 U.S.C. §102, each and every element of the claims in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants submit

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that independent claim 1 patently define over the prior references for at least the reason that the cited art fails to disclose each and every feature as claimed in the present invention.

Claims 1 and 9 teach, among other things, "...selecting a plurality of probe molecules, wherein an affinity exists between each of the probe molecules and one of corresponding specific molecules on a cell membrane...". Contrary to the Office's assertion, Okamoto does not teach the above features. Instead, Okamoto teaches the probe molecule being nucleic acid which is complementary and is used to detect a target nucleic acid to identify a base sequence. There is no teaching or suggestion in Okamoto that the probe molecules selected have an affinity exist between each of the probe molecule and specific molecules on a cell membrane. Accordingly, Applicants respectfully submit that Okamoto cannot possibly anticipate the claimed invention in this regard.

Accordingly, Okamoto fails to teach or disclose all limitations as recited in the independent claim 1. Claims 2, 4-6 and 9 depend from independent claim 1, and therefore are not anticipated by the reference Okamoto for at least the reasons noted above, as well as for the additional features recited therein. Therefore, reconsideration and withdrawal of these 102 rejections are respectfully requested.

The Office Action rejected claim 3 under 35 USC 103(a) as being unpatentable over Okamoto in view of Chen et al. (US Patent 6,594,432, hereinafter Chen).

The Office Action rejected claims 7 and 8, under 35 USC 103(a) as being

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unpatentable over Okamoto in view of Oprandy (US 5,200,312).

Applicants respectfully disagree and would like to point out that even though the Examiner relied upon Chen for teaching the quality control probes, and further Oprandy for teaching the step of drying after an incubation step and before cleaning, still neither Chen nor Oprandy can cure the specific deficiencies of Okamoto. Accordingly, claims 3, 7-8 also patently define over combination of Okamoto and Chen or Oprandy for at least the same reasons discussed above. Reconsideration is respectfully requested.

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CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,

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